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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/842,371

04/25/2001

Diane C. Breidenbach

6561

7590

09/28/2006

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EXAMINER

NGUYEN, TUAN N

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,371

Applicant(s)

BREIDENBACH ET AL. C

Examiner

Tuan N. Nguyen

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 1-41 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Amended claims 1-41 are directed to the non-elected invention that is independent or distinct from the elected invention originally claimed for the following reasons: "at least one end of said receptacles having having a rollerball applicator" in lines 7-8 of claim 1.

Since applicant has received an action on the merits for the originally elected invention Species I: Fig. 2, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-41 and 51 (which is previously withdrawn) are withdrawn from further consideration as being directed to a non-elected invention.

Response to Arguments

2. Applicant's arguments with respect to claim 1 have been considered but are moot as indicated above.
3. Applicant's arguments filed 9/5/06 have been fully considered but they are not persuasive as indicated in the rejections below.

Claim Objections

4. Claim 47 is objected to because of the following informalities: there are two ending period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claim 50 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The amended independent claim 42, lines 7-8, has already claimed the diameter of the receptacles is the same since they are the same with the diameter of the sleeve, which inherently yield the same diameter of the cross section of the receptacles. However, claim 50 is now claiming "the diameter of the cross section of the receptacles is different." This raised an unclear question as to whether the diameter of the receptacle is the same or different. If the diameter is different, then the limitation in lines 7-8 of claim 42 is considered inaccurate.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 42 and 48-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakwa.

Sakwa discloses a dual ended container (see Fig. 4) comprising a sleeve (12) that has a first end (about 26) and a second end (about 28), each of the ends being adapted to receive a receptacle (about 16, about 50) for containing a product and wherein the product in the first receptacle is different from the product in the second receptacle and at least one of the receptacles has a rollerball applicator (14) for dispensing product from that receptacle, the receptacle with the rollerball applicator

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having a first end and a second end, the first end having the rollerball applicator (14) and being removably connected to the sleeve (12) as shown in Fig. 3; wherein the sleeve has a diameter and the receptacles have a diameter (see Figs. 3 and 4 where 72 is pointing) and wherein the diameter of the sleeves and the receptacles are generally the same. The receptacles have a sidewall (the side wall of 72 that abutting side wall of where 76 is pointing), wherein the sidewall of the first receptacle is parallel to the sidewall of the second receptacle (see Fig. 4). The receptacles having an end wall (see Fig. 4, end wall 50 and the same of 16 that is inserted into sleeve 12), the end walls of the receptacles being generally parallel to each other and perpendicular to the sidewall. The sleeve has a first section and a second section which are connected by a sidewall (22), the first section and the second section being opened at each of said ends and is capable of receiving an opened end of a receptacle which contains a product. The sleeve and the receptacles have a cross section of the same shape, wherein the center axis of each end section is the same and wherein the center axis of the sleeve and each of the receptacles are the same.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 42-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roehrich in view of US Patent 5,586,694 (hereinafter Breidenbach), Costa, or Pieper et al. (hereinafter Pieper), or any combination thereof.

Roehrich discloses a dual ended container (see Fig. 1) comprising a sleeve (middle piece between the top and bottom piece) that has first and second ends, each of the ends being adapted to receive a receptacle (the top and bottom piece) for containing a product (such as perfume or the like) and wherein the product in the first receptacle could be different from the product in the second receptacle depend on the user wishes. The receptacles have an end wall (the bottom end wall of each bottle). The sleeve could obviously have a first section and a second section, which are connected by a sidewall (if not already) such that taught by Costa partition wall (1a). At least or only one of the receptacles can have a rollerball applicator (if not already) for dispensing product from that receptacle similar to the rollerball applicator of Breidenbach (see Fig. 5 of Breidenbach). Although the Roehrich receptacles are tapered; however, same diameter receptacles and sleeve are shown by Costa. Therefore, modifying the shape of the receptacles to have the same diameter as the sleeve would involve merely design choice. In so doing, the end walls of the receptacles of Roehrich would obviously be generally parallel to each other and perpendicular to the sidewall. Furthermore, the intended use with different product and all other functional phrases have been carefully considered but are deemed not to describe any structure patentably distinguishable over the device that disclosed by Roehrich which is certainly capable of being used in the claimed manner such as with a

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receptacle with a mascara brush as for example discloses by Costa or a doe foot applicator as for example discloses by Pieper.

8. The affidavit under 37 CFR 1.132 filed 4/3/06 is insufficient to overcome the rejection of claims 1-31 and 40-50 based upon the evidence is not commensurate with the scope of the claims as set forth in the last Office action because: in order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features; other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims; there is no evidence showing the commercial success alleged is directly derived from the invention claimed; the applicant must show that the claimed features were responsible for the commercial success of an article; and evidence of commercial success must be clearly attributable to the design to be of probative value, and not to brand name recognition. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Conclusion

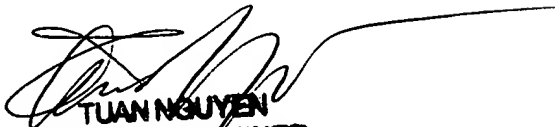
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan N. Nguyen whose telephone number is 571-272-4892. The examiner can normally be reached on Monday-Friday (10:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine R. Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


TUAN NGUYEN
PRIMARY EXAMINER
9/22/06